

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARLENE E. GWON and MICHAEL W. BERNES

Appeal No. 1997-2646
Application 08/103,089

ON BRIEF

Before HAIRSTON, JERRY SMITH, and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-26. Claims 1-3, 7-9, 15-18, and 20-25 were amended in the response filed December 18, 1995.

The invention relates to a method of laser photoablation of ocular lens tissue. The method comprises steps of determining the volume of lens tissue to be photoablated and

directing a pulsed laser beam at such a volume with an amount of energy effective for photoablating the region without causing substantial damage to the surrounding tissue.

Independent claim 1 is as follows:

1. A method for selective removal of ocular lens tissue, for the correction of vision defects, said method consisting essentially of the steps of:

point focusing a laser into an ocular lens with a focal
point below an anterior surface of the ocular lens where
ablation is intended to occur;

pulsing said laser at said focal point; and

moving the laser focal point towards the ocular lens
anterior surface and pulsing said laser at a selected
volume of ocular lens, where ablation is intended to
occur, said selected volume being of a size enabling
resolve by adjacent healthy ocular lens tissue.

The Examiner relies on the following references:¹

L'Esperance, Jr.	4,538,608	Sep. 3, 1985
Bille et al. (Bille)	4,907,586	Mar. 13, 1990

Claims 1-26 stand rejected under 35 U.S.C. § 112, second paragraph, claim 17 stands rejected under 35 U.S.C. § 102 in view of Bille, claims 1-8, 18, and 20-24 stand rejected under 35 U.S.C. § 103 in view of Bille, and claims 9-16, 19, 25,

¹The examiner's answer mailed October 13, 1995 also lists Aron Nee Rosa et al. as prior art of record. However, only Bille and L'Esperance are used as a basis for a rejection.

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and 26 stand rejected under 35 U.S.C. § 103 in view of Bille and L'Esperance, Jr.

Appellants have indicated that claims 1-16 and 18-26 stand or fall together while claim 17 forms a separate group.

Rather than reiterate all arguments of Appellants and Examiner, reference is made to the briefs and answers for the respective details thereof.²

OPINION

We will not sustain the rejection of claims 1-26 under 35 U.S.C. § 112, second paragraph. In addition, we will not sustain the rejection of claim 17 under 35 U.S.C. § 102(b) or of claims 1-16 and 18-26 under 35 U.S.C. § 103.

Turning first to the rejection of claims 1-26 under 35 U.S.C. § 112, second paragraph, the Examiner first asserts that if claims are read in light of the specification, they "inherently require ablation." The Examiner goes on to assert

² See the briefs filed May 8, 1995, December 18, 1995, and April 5, 1999, as well as answers mailed October 13, 1995, March 21, 1996, and August 17, 2000. A communication was mailed July 16, 1996 informing Appellant that amended claims and reply brief filed December 18, 1995 would be entered.

that the claims "require the removal [of a volume] 'being of a size enabling resolve by adjacent healthy ocular lens tissue'." Based on these assumptions, the Examiner concludes that a conflict in claim language exists in that: (1) claim language fails to recite a step of removal; (2) the "removed" tissue is then restored to normal, or resolved, while it is "apparently now outside of the lens."³

On page 6 of the reply brief, Appellants argue that "[the language at issue] distinctly claims the subject matter which the Appellants regard as the invention. The Appellants have not claimed a step of 'ablating' by laser, but a step of focusing and pulsing at a volume to be removed, with such removal being effected by adjacent tissues." We are directed by appellants to page 23, lines 10-12, of the specification for support.

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of

³ See page 2 of answer mailed August 17, 2000 (hereinafter paper no. 28).

the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. ***In re Johnson***, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977); ***citing In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph. ***See In re Hyatt***, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983); ***citing In re Borkowski***, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970). "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." ***In re Warmerdam***, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

We find that the claims at issue set out and circumscribe methods of selective removal and of increasing an accommodation of amplitude of an ocular lens with a reasonable degree of precision and particularity. They also apprise the person of ordinary skill in the art of the scope of the

invention. We agree with Appellants that the invention is directed to the step of focusing and pulsing at a volume to be removed, with such removal being effected by adjacent tissues. This is further supported by Appellant's specification, page 23, lines 10-12. We agree that the claim scope is broad but the proper rejection for breadth is under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph.

Turning next to the rejection of claim 17 under 35 U.S.C. § 102(b), the method of claim 17 includes a step of selecting a volume of ocular lens tissue to be removed. The specific volume selected is identified as being of "a size enabling resolve by adjacent healthy ocular lens tissue." The Examiner acknowledges that Bille fails to explicitly disclose removal of the specific volume of lens tissue recited in claim 17.⁴ However, Examiner goes on to conclude that the reference must inherently include the limitation in question. The Examiner's arguments of inherency are based on an assumption that, as Bille fails to discuss surgical removal of lens tissue, the invention disclosed therein must inherently resolve the tissue

⁴See pages 9-10 of the answer mailed August 17, 2000.

acted upon by a laser in order to accomplish its removal.⁵

Appellants argue that Bille fails to teach selection of a volume of tissue which would enable resolve by adjacent tissue.⁶

"Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention."

RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), **cert. dismissed**, 468 U.S. 1228 (1984), **citing Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983). Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" **In re Robertson**, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), **citing Continental Can Co. v. Monsanto Co.**, 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

⁵ See page 10 of the answer mailed August 17, 2000.

⁶ See page 10 of the reply brief.

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient."

Id. citing *Continental Can*, 948 F.3d at 1269, 20 USPQ2d at 1749.

Bille's silence as to the surgical removal of tissue in no way makes clear that resolve of tissue acted upon by a laser is necessarily a part of Bille's invention. The Examiner provides no basis for the assumption that surgery and resolve are the only two methods for removal of tissue acted upon by a laser which would have been available to one of ordinary skill in the art. Thus, even if the assumption is made that surgery could not have formed a part of Bille's invention, there are other methods of removal other than by resolve. Therefore, we find that Bille does not anticipate the invention as recited in claim 17.

We turn next to the rejection of claims 1-8, 18 and 20-24 under 35 U.S.C. § 103 over Bille and of claims 9-16, 19, 25, and 26 over Bille in view of L'Esperance.

The Federal Circuit states that "[t]he mere fact that the

prior art may be modified in the manner suggested by Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." ***Pro-Mold & Tool Co. v. Great Lakes Plastics***, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), ***citing In re Rinehart***, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in ***Para-Ordnance Mfg. v. SGS Importers Int'l Inc.***, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have reasonably expected to use

the solution that is claimed by Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Paradornance** 73 F.3d at 1087, 37 USPQ2d at 1239; **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13, **cert. denied**, 469 U.S. 851 (1984). In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999)

In the rejections under 35 U.S.C. § 103, the Examiner relies on the same arguments presented for claim 17 as a basis for asserting that Bille must inherently include this feature.⁷ However, as discussed above with respect to the rejection of claim 17, the Examiner fails to establish that Bille explicitly or implicitly discloses use of the specific amount of tissue recited in the claimed invention. No arguments are presented as motivation for one of ordinary skill in the art to modify Bille to include this feature.

⁷ See pages 25-27.

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Therefore, we find that the Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordinance*** 73 F.3d at 1087, 37 USPQ2d at 1239; ***citing W. L. Gore*** 721 F.2d at 1548, 220 USPQ at 309.

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For these reasons we reverse the rejection of claims 1-26
under 35 U.S.C. § 112, second paragraph; of claim 17 under
35 U.S.C. § 102(b); and of claims 1-16, and 18-26 under 35
U.S.C. § 103.

REVERSE

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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